REMARKS – General

Claim Rejections under 35 USC §101:

The most recent Office Action (OA) rejects claims 32-80 and 93-98 as being unpatentable under 35 USC §101. Specifically, the OA notes that the claims, as originally filed, are not limited to tangible media, but instead include intangible media, for example a "transmission medium". Further, the OA states that independent claims 50 and 93 recite a system and a device, without any structure and that are comprised solely of codes, which is non-statutory. In support of this rejection, the OA cites MPEP §2106, §IV.

In responding to the rejection, Applicants respectfully note that according to MPEP §2106, "...Congress chose the expansive language of 35 U.S.C. 101 so as to include 'anything under the sun that is made by man'." *Diamond v. Chakrabarty*, 447 U.S. 303, 308-09, 206 USPQ 193, 197 (1980). The Federal Circuit notes that laws of nature, physical phenomena, and abstract ideas are the only three exceptions to §101 set forth by the Supreme Court. *State Street Bank & Trust Co. v. Signature Financial Group Inc.*, 149 F.3d 1368, 47 USPQ2d 1596 (Fed. Cir. 1998) at 1373. The court in *State Street* held that a machine programmed with software "...admittedly produces a 'useful, concrete, and tangible result.' This renders it statutory subject matter..." *Id.* at 1375. The fact that a computer, or memory medium, containing code capable of producing a useful, concrete, and tangible result *is* statutory subject matter under 35 USC §101 is confirmed in MPEP Section 2106 IV B 1 which states, "When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of technology permits the function of the descriptive material to be realized." Section 2106 states that "'functional descriptive material' consists of data structures and computer programs which impart functionality when employed as a computer component."

As machines or memory media storing or programmed with code is statutory subject matter under both the MPEP and Federal Circuit case law, Applicants have amended claim 32 to recite "A network-based data packet delivered from a computer

system to a target device" wherein the networked-based data packet includes content instrumented with billing tracking code. Support for this amendment is found in claim 31 as originally filed (data transmission packets) and FIG. 4 (computer system to target device). Applicants respectfully submit that claim 32, as amended, recited content being delivered by a computer system to another device for the purpose of generating billing data. This generation of billing data is a useful, concrete, and tangible result. As such, Applicants respectfully submit that claim 32, as well as the claims depending from claim 32 which have been amended in like fashion for proper antecedent basis, recite statutory subject matter under 35 USC §101. Applicants respectfully request reconsideration of the rejection in light of these comments and the amendments to claims 32-49.

Regarding claim 50, Applicants have amended the claim to recite a transmission-based billing system in a computer environment programmed to automatically generate billing data for content that executes on a client device. The billing system includes a content modifier component that instruments the content with billing code. The content modifier component may be stored in memory and executable on one or more CPUs, as recited in Applicants' specification at paragraph 40. Support for the amendment to claim 50 is found in paragraph 40 of the specification as originally filed and in FIG. 4. Support for the amendment to claim 65 and 67 is found in paragraph 33 of the specification as originally filed and in FIG. 3. Support for the amendment to claim 72 is found in paragraph 51 of the specification as originally filed and in FIG. 13. Support for the amendment to claim 77 is found in paragraph 47 of the specification as originally filed and in FIG. 9. Applicants respectfully submit that a system programmed with components, such as the content modifier, recite statutory subject matter in accordance with both the MPEP and Federal Circuit case law. Applicants respectfully submit that claim 50, as well as the claims depending from claim 80 which have been amended in like fashion for proper antecedent basis, recite statutory subject matter under 35 USC §101. Applicants respectfully request reconsideration of the rejection in light of these comments and the amendments to claims 50-80.

Regarding claim 93, Applicants have amended the claim to recite a wireless device having a modified content application to log and transmit data. Support for the amendment is found in paragraph 38 of the specification as originally filed and in FIG. 4.

Applicants respectfully submit that a wireless device having an executable application resident in memory and operable with a CPU to generate a useful, concrete, and tangible result, such as enabling the server system to bill a subscriber, is statutory subject matter under 35 USC §101. Applicants respectfully request reconsideration of the rejection to claim 93 and dependent claims 94-98, in light of the amendments to claims 93, 96, and 98.

Claim Rejections under 35 USC §112:

The OA rejects claims 32-80 and 93-98 as being unpatentable under 35 USC §112. Specifically, the OA submits, "The claims are in narrative form and are replete with indefinite and functional or operational language."

Applicants note that many of these claims have been amended in responding to the rejections under 35 USC §101 above. Applicants believe the claims to now recite properly structured apparatus and methods that particularly point out and distinctly claim the subject matter of the invention. Further, Applicants respectfully rely upon MPEP §2173.01, which states that an "[a]pplicant may use functional language, alternative expressions, negative limitations, or any style of expression or format of claim which makes clear the boundaries of the subject matter for which protection is sought. As noted by the court in *In re Swinehart*, 439 F.2d 210, 160 USPQ 266 (CCPA 1971), a claim may *not be rejected* because of the type of language used to define the subject matter for which patent protection is sought." Applicants respectfully submit that the claims are now in proper form, and that any §112 rejections have been overcome. Applicants note that specific rejections were not included in the most recent OA. Applicants respectfully request reconsideration of the rejection in light of the amendments to the claims and these comments.

With respect to claim 43, the OA rejects claim 43 submitting that the claim, as originally filed, is "indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention." Specifically, the OA notes that there is insufficient antecedent basis for "the security key" in claim 43.

Applicants have amended claim 43 to refer to claim 42 instead of claim 32 as originally filed. Claim 42 recites "a security key", thereby providing antecedent basis for

"the security key" in claim 43. Applicants respectfully request reconsideration of the rejection in light of the amendment.

Claim Rejections Under 35 USC §103:

  The OA rejects claims 1, 2, 5, 20, 21, 27, 28, 32, 33, 36, 47-51, 54, and 77 under 35 USC §103 as being unpatentable over Tucciarone et al., US Pub. Appn. No. 2003/0009385, hereinafter "Tucciarone", in view of Walter et al., US Pub. Appn. No. 2002/0022471, hereinafter "Walter", in view of Sussman, US Pat. No. 4,961,158. Specifically, the OA submits that Tucciarone teaches an electronic messaging system wherein the architecture includes making use of a billing transaction mechanism, such as a billing tracking code generator. The OA states that Tucciarone is silent on the billing tracking code automatically communicating billing data "…based upon an amount of data transmitted after the content/billing information is modified", but that Walter discloses "…billing algorithms and billing applications residing on wireless device/user device for metering data, wherein charges are calculated based on the amount of volume of data downloaded or uploaded from wireless device…" The OA then states that Sussman "…discloses determining billing tracking code, instructing determined billing tracking code in to the content, thereby modifying the content, modified content is executed on the target device." The OA then concludes that it would have been obvious to one of ordinary skill in the art at the time of the invention to be motivated to implement billing/tracking code automatically to communicate billing data based upon an amount of data transmitted. Applicants respectfully traverse this rejection.

  Beginning with claim 1, Applicants respectfully submit that none of the references teach instrumenting a billing tracking code into content as recited by Applicants. Applicants note that the content referred to in claim 1 includes applications and services provisioned by a user from a client device. *Applicants' specification,* paragraph 5. In Applicants' claim 1, a billing tracking code is instrumented into the content.

  The OA relies on the Sussman reference as teaching an instrumentation of a billing tracking code into content. Applicants respectfully traverse this interpretation. Applicants respectfully note that Sussman teaches a handheld calculator or timepiece that

is capable solely of storing, editing, deleting, or outputting a form of billing tracking code. *Sussman*, col. 1, lines 5-9. These codes, as noted by Sussman, are stored in memory to track a variety of items, including television ads, foodstuffs, consumer merchandise, or antiques. *Sussman*, col. 1, lines 14-29. Sussman fails to teach instrumenting the codes, depicted in FIGS. 3c, 4c, and 5b, into any of these products.

Similarly, neither Walter nor Tucciarone teaches instrumenting code into content provisioned by a user. Walter teaches only a metering application. Tucciarone teaches an e-mail system where e-mails are only received from approved sources. The combination of Tucciarone, Walter, and Sussman fails to teach instrumenting code into the content itself, as is recited by Applicants' claim 1.

Further, the combination fails to teach a billing tracking code that "…automatically communicates billing data…" "…when the content is executed on a target device…" as recited by Applicants in claim 1. While the OA submits that Walter teaches "…billing algorithms and billing applications residing on wireless device/user device for metering data, wherein charges are calculated based on the amount of volume of data downloaded or uploaded from wireless device…", Applicants respectfully submit that this is not billing tracking codes that automatically communicate billing data upon execution. Quite to the contrary, Walter merely teaches a metering application configured to calculate amounts of data transmitted by time or amount. To be sure, were the billing tracking data of Tucciarone or Sussman transmitted through the meter of Walter, this tracking data would be treated as data itself, and would be metered. The tracking data would have no effect on the metering operation.

Not only does the combination fail to teach such automatic communication of data, but also the combination expressly teaches away from Applicants' invention in that a metering application, which is independent of the billing tracking data, is required.

Applicants note that independent claims 32 and 50, from which claims 2, 5, 20, 21, 27, 28, 33, 36, 47-49, 51, 54, and 77 depend, include the limitations found in claim 1 mentioned above. Applicants respectfully request reconsideration of the rejections to these claims based upon these comments.

Claims 9, 10, 40, 41, 58, and 59 are rejected as claim 1 above, further in view of Sears et al., US Pub. Appn. No. 2002/0069263, hereinafter "Sears". Applicants respectfully submit that Sears additionally fails to teach instrumenting billing tracking code into the content as recited by Applicants. Applicants respectfully request reconsideration of these rejections per the comments regarding claim 1 above.

Claims 42, 60, and 62 are rejected as claim 1 above, further in view of Rojas, US Pub. Appn. No. 2001/0019605. Applicants respectfully submit that Rojas additionally fails to teach instrumenting billing tracking code into the content as recited by Applicants. Applicants respectfully request reconsideration of these rejections per the comments regarding claim 1 above.

Allowable Subject Matter:

Applicants kindly thank the Examiner for noting that claims 81-92 are allowed over the prior art. Applicants note that the OA states that claims 11-14 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. Applicants believe claims 11-14 to be allowable in light of the comments regarding claim 1 above.

CONCLUSION

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. No amendment made was for the purpose of narrowing the scope of any claim, unless Applicant has argued herein that such amendment was made to distinguish over a particular reference or combination of references.

For the above reasons, Applicants believe the specification and claims are now in proper form, and that the claims all define patentably over the prior art. Applicants believe this application is now in condition for allowance, for which they respectfully submit. If any matter may be more easily handled by telephone, the undersigned attorney welcomes telephone calls from the Examiner.

Respectfully submitted,

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